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09/827,841	04/06/2001	Sumihiro Okawa	SONYJP 3.0-152	6651

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EXAMINER

DANG, KHANH NMN

ART UNIT	PAPER NUMBER
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2111

DATE MAILED: 02/24/2004

11

Please find below and/or attached an Office communication concerning this application or proceeding.

8

Office Action Summary

Application No.

09/827,841

Applicant(s)

OKAWA ET AL.

Examiner

Khanh Dang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 6-24 are rejected under 35 U.S.C. 112, first paragraph, because the best mode contemplated by the inventor has not been disclosed. Evidence of concealment of the best mode is based upon the fact that the distinctions between what is claimed as Applicant's invention and the IEEE 1394 specification have not been clearly set forth in both the originally filed specification and the drawings. Whatever belongs to the IEEE 1934 specification must be disclosed under "Background of the Invention" and labeled as -Prior Art - both under the "Brief Description of the Drawings" and in the Drawings.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the

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applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 6-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Okawa et al.

At the outset, it is first noted that similar claims will be grouped together to avoid repetition in explanation.

As broadly drafted, these claims do not define any structure/step that differs from Okawa et al. With regard to claim 6, Okawa et al. discloses an electronic equipment, comprising a bus (IEEE 1394 bus); an interface unit (IEEE 1394 interface) for digital serial data connected to the bus (IEEE 1394 bus), the interface unit (IEEE 1394 interface) having a physical layer (see at least Figs. 8 and 9) in conformity with the IEEE 1394 standard; at least one partner (any I/O/Peripheral device or Node in 1394 protocol) connected to the bus, each connected partner having a physical layer (must be a 1394 device to be connected to a 1394 bus) which conforms to the IEEE 1394 standard; and a processor (host, for example) connected to the interface unit; the interface unit including a transmitter (Tx for arb signals) for transmitting an arbitration signal to each

connected partner, and a receiver (Rx for arb signals) receiving an arbitration signal from each connected partner, wherein, in a bus initialization phase (power on/off, adding/removing nodes in 1394 protocol), a bus reset signal (also "reset signal" in Okawa et al.) is sent to each connected partner (node in 1394 protocol) for a predetermined period of time in a reset start state of the interface unit, and when it is acknowledged that a specified period of time has elapsed and bus reset signals have been received from each connected partner, the interface unit enters a reset wait state (or in another word, in 1394 systems including Okawa et al.'s 1394, the 1394 serial bus automatically recognizes a node having a node ID connected to the cable for the 1394 interface. When a node is removed from the interface, or a new node is added to the interface, the bus is automatically reset (to reflect the change, for example, the priority level between nodes). Therefore, during initialization (power ON, for example), a 1394 bus reset must be sent to each connected node to determine whether the network construction remains the same (same nodes) or may include new nodes that may be added or nodes that may be removed during the power OFF period, since the priority level, for example, between nodes may change and thus, may require arbitration again. When the reset signal is sent to one node, the 1394 physical layer of the respective node receives the bus reset signal, and at the same time, notifies the link layer of the occurrence of bus reset, and forwards the bus reset signal to the other nodes. It is clear that it takes a specified "predetermined period of time" for all nodes to receive/acknowledge the reset signal from the host depending on a number of nodes corresponding to a particular design. After all nodes receive reset signal or the "reset

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start state" ends, the 1394 interface of Okawa et al. will "wait" for another reset which may occur during power ON/OFF, adding/removing 1394 nodes.

With regard to claim 7, it is clear that after a reset state is completed or in another word, after all nodes acknowledge the reset signal, the interface unit enters a "reset wait state" to wait and be ready for a next reset event.

With regard to claim 8, the system of Okawa et al. must be in full compliance with 1394 protocol, and the transmitter Tx transmits a reset signal to each node.

With regard to claim 9, it is clear that in Okawa et al., the system of Okawa et al. must be in full compliance with 1394 protocol. Therefore, in Okawa et al., the idle state or idle signal is transmitted onto the 1394 bus after passage of a predetermined period of time.

With regard to claims 10 and 11, it is clear that the system of Okawa et al. must be in full compliance with 1394 protocol. That is, the Tree Identify Protocol (TIP) of the IEEE1394 must be performed after the idle state and after a parent/child status request from a node. See also Tables 4(a-c), Tables 5 (a-c), and description thereof.

With regard to claim 12, it is clear that each node (or device) of Okawa et al. includes a processor.

With regard to claim 13, it is clear that the 1394 bus is bi-directional or duplex.

With regard to claims 14 and 15, it is clear that the 1394 system of Okawa et al. must be fully compliance with all standard 1394 protocol including the IEEE P1394a specification.

With regard to claim 16, see discussion above.

With regard to claims 17-24, it is clear that one using the 1394 system of Okawa et al. must have performed the same steps set forth in claims 17-24.

Response to Arguments

Applicants' arguments filed 12/15/2003 have been fully considered but they are not persuasive.

At the outset, Applicants are reminded that claims subject to examination will be given their broadest reasonable interpretation consistent with the specification. *In re Morris*, 127 F.3d 1048, 1054-55 (Fed. Cir. 1997). In fact, the "examiner has the duty of police claim language by giving it the broadest reasonable interpretation." *Springs Window Fashions LP v. Novo Industries, L.P.*, 65 USPQ2d 1862, 1830, (Fed. Cir. 2003). Applicants are also reminded that claimed subject matter not the specification, is the measure of the invention. Disclosure contained in the specification cannot be read into the claims for the purpose of avoiding the prior art. *In re Sporck*, 55 CCPA 743, 386 F.2d, 155 USPQ 687 (1986).

With this in mind, the discussion will focus on how the terms and relationships thereof in the claims are met by the references. Response to any limitations that are not in the claims or any arguments that are irrelevant and/or do not relate to any specific claim language will not be warranted.

The 112, 1st paragraph Rejection:

As pointed out above, evidence of concealment of the best mode is based upon the fact that the distinctions between what is claimed as Applicant's invention and the IEEE 1394 specification have not been clearly set forth in both the originally filed specification and the drawings. In another word, the specification is ambiguously written so that one cannot determine which portion of the specification involves the claimed invention and which portion is the IEEE1394 specification. For example, Fig. 8 is described in the disclosure as if it is a part of the claimed invention whereas it is clearly that Fig. 8 is a part of the IEEE 1394 specification. Therefore the disclosure is inadequate to enable one of ordinary skill in the art to practice the best mode. According to the approach used by the court in *Chemcast Corp. v. Arco Industries*, 913 F.2d 923, 16 USPQ2d 1033 (Fed. Cir. 1990), a proper best mode analysis has two components:

(A) Determine whether, at the time the application was filed, the inventor knew of a mode of practicing the claimed invention that the inventor considered to be better than any other.

In the instant case, it is clear that Applicants must at least know what the claimed invention is, apart from the IEEE 1394 specification, to distinguishably describe the invention.

(B) Compare what was known in (A) with what was disclosed - is the disclosure adequate to enable one skilled in the art to practice the best mode?

In the instant case, comparing what was known and what was disclosed, it is clear that the disclosure is inadequate to enable one of ordinary skill in the art to practice the best mode. One simply cannot practice the best mode without knowing what portion of the disclosure may be the claimed invention.

Applicants also argued that "the Examiner has not pointed to a better mode for practicing the invention." In response to Applicants' argument, the Examiner is not required to provide better mode according to 35 USC 112, 1ST paragraph. As a matter of fact, only the Applicants who can provide the best mode or "better mode."

The Okawa et al. 102 Rejection:

Applicants argued that "Okawa et al. does not teach the communication of signals and change of state by an interface unit only after receipt of response from each partner communication device, and in response to passage of a predetermined period of time." Contrary to Applicants' argument, in the Okawa et al. 1394 system, fully in compliance with 1394 specification, the 1394 interface receives response/ack from each node acknowledging that the reset signal has been received during a reset state. After a predetermined period of time when the reset signal is acknowledged by all nodes, the interface changes from a reset state to a reset wait state. In another word, when the reset signal is sent to one node, the 1394 physical layer of the respective node receives the bus reset signal, and at the same time, notifies the link layer of the occurrence of bus reset, and forwards the bus reset signal to the other nodes. It is clear that it takes a

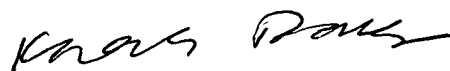
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specified "predetermined period of time" for all nodes to receive/acknowledge the reset signal from the host depending on a number of nodes corresponding to a particular design. After all nodes receive reset signal or the "reset start state" ends, the 1394 interface of Okawa et al. will enter the reset wait state to "wait" for another reset which may occur during power ON/OFF, adding/removing 1394 nodes.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Khanh Dang at telephone number 703-308-0211.



Khanh Dang
Primary Examiner